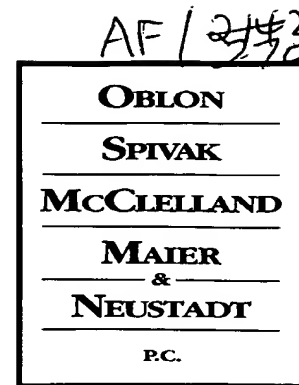




Docket No.: 214149US99M CONT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



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Technology Center 2100

RE: Application Serial No.: 09/095,325

Applicants: Gene EGGLESTON, et al.

Filing Date: June 10, 1998

For: MOTOROLA V. RESEARCH IN MOTION--METHOD
AND APPARATUS FOR RATE GOVERNING
COMMUNICATIONS

Group Art Unit: 2142

Examiner: CORDONE, J.

SIR:

Attached hereto for filing are the following papers:

REPLY BRIEF (IN TRIPLICATE)

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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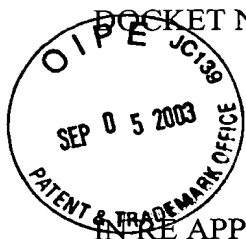
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Registration No. 45,265

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DOCKET NO.: 214149US99M CONT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

GENE EGGLESTON ET AL.

SERIAL NO: 09/095,325

CPA FILED: SEPTEMBER 18, 2001

FOR: METHOD AND APPARATUS
FOR RATE GOVERNING
COMMUNICATIONS

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: EXAMINER: CARDONE

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: GROUP ART UNIT: 2149

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SEP 10 2003

Technology Center 2100

REPLY BRIEF

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Please consider the following remarks in response to the July 08, 2003 Examiner's

Answer.

I. Group I

The claims of group 1 recite "a forwarding component associated with a host system." Appellants asserted in their appeal brief (hereinafter "brief") that the communication server 220 is associated with the post office host server 240. See page 8 lines 14-25 of the specification. Moreover, Appellants asserted in their brief that the communication server 220 is configured to receive electronic email messages generated by the mobile client 201 and to forward the same to a message recipient. See Figure 4 steps 430 – 444 and page 16 lines 12-34. Likewise, Appellants pointed out that the post office host server 240 can be configured to have the same functionality as the communication server. See page 8 lines 14-17. Hence, Appellants submitted in their brief that at least one of the communication server 220 and the

post office host server 240 is a forwarding component associated with a host system as defined by Claims 104, 105, and 109-114.

The Examiner asserts on page 4 lines 8-10 of his answer that "It can be conceived that the email post office is upon the communication, but it is not *directly* associated with the host."¹ Appellants respectfully disagree. Appellants first point out that the claims of group I do not require a direct association between the forwarding component and the host system of the specification. Further, Appellants point out that page 8 lines 25-31 of the specification state that:

It should be understood that for purposes of this application, a first device or component is responsive to or in communication with a second unit or component regardless of whether the first and second units are directly coupled or indirectly coupled, such as via intermediate units, including switches that operatively couple the units for only a segment of time, as long as a signal path can be found that directly or indirectly establishes a relationship between the first and second units.

Hence, once of ordinary skill in the art during the 1995 time frame would have understood from the specification that the post office server 240 and the communication server 220 can be in either indirect or direct communication with one another and that one of those two components functions to forward email to a message recipient.

Next, the Examiner asserts in his answer that "there is no mention (within the citations of the appellant or the specification) of forwarding the electronic mail to the message recipient." Appellants again respectfully disagree. Page 6 line 1-11 of the specification discloses an embodiment where the user of client 201 creates a reply message and an optimized reply message is generated by the client 201 and is forwarded to the communication server 220. The communication server ultimately "forwards the full reply to the addressee." Another example can be found at page 22 lines 28-30 of the specification

¹ Italics added for emphasis.

which discloses that, "[o]nce reconstructed, the reply messages is forwarded to the target unit(s)" Further, page 21 lines 18-26 and page 22 et seq. of the specification disclose that:

Thus, for example, where both the originating and *target* clients are active and served by the same communication server and thus are known to have optimized reply capabilities, and the *target* client was an addressee or originator of the preceding message identified by the message identifier of the optimized reply, a reconstructed reply may not be required.

* * *

In cases where the *target* unit is not an active client with the communication server, the QM (or other appropriate entity of the controller) functions to reconstruct the reply message from the optimized reply. Because the communication server preferably does not retain a copy of client mail or data located on other hosts (such remote stores typically adding complexity and cost, while being unnecessary in view of the virtual session established via the communication server), it would use the identifier to retrieve the preceding message from the host (e.g., send a query object or message to the appropriate post office) (steps 908-912).²

Hence, at least one of the communication server 220 and the post office host server 240 is a forwarding component associated with a host system for forwarding emails to a message recipient as defined by claims 104, 105, and 109-114.

II. Groups II and IV

Appellants submitted in their brief that one of ordinary skill in the art during the 1995 time frame would have understood from the figures and the corresponding description thereof that all email messages to and from the mobile unit are processed and/or recorded by the post office which includes a mailbox having a first address. The Examiner argues on page 6 lines 18-20 of his answer that:

[t]here is no mention (within the citations of the appellant or the specification) of shared addressing between the mobile client 9 (or user) and the host for receiving messages from

² Italics added for emphasis.

senders (i.e. receiving messages directed to a first addressee at/associated to the host" for the mobile client).

Appellants disagree. Appellants believe that one of ordinary skill in the art during the 1995 time frame would have understood from Figure 9 and page 22 lines 1-30 of the specification that the client's post office box resides on the host/server. See for example page 22 lines 10-12 of the specification, which disclose that "[t]his can be implemented by requesting the preceding message from the client inbox" and steps 910 and 912. Steps 910 and 912 occur at the communication server and host/server, respectively, and not at the mobile client. Further, page 22 lines 28-30 of the specification disclose that: "[o]nce reconstructed, the reply message is forwarded to the target unit(s), as well as to the outbox or sent mail folder of the client's post office box (steps 914-916)." Again, steps 914 and 916 occur at the communication server. See Figure 9. That is, one of ordinary skill in the art during the 1995 time frame would have understood from Appellants specification that the mobile *client* does not have an email address or email functionality. Rather, the *server* (host system) provides the email address and functionality for the client. Hence, Appellants' specification does provide written description support for the "transparency" feature of the claims of Group II and IV.

III. Continuously Forwarding (Groups III and IV)

The Examiner asserts on page 8 lines 10-13 of his answer that:

In fact, the communication server, working with the client, does pull the email from the host for the mobile client. Since, the specification discloses that the communication server queries the host in intervals, this is contradictory of the claimed invention of the host 'continuously forwarding' the incoming email.

In response, Appellants reiterate that the specification provides support for the "continuously forwarding" feature of the claims of groups III and IV. Figure 3 and the corresponding disclosure at page 12 lines 1-29 clearly show that new mail received for the mobile client is

forwarded to the mobile client via the host system independent of any proactive step by the user of the mobile client. See steps 320-324 of Figure 3. The forwarding process begins with query manager 231 of the communication server 220 and not the mobile client 201. Hence, the newly received mail is "continuously forwarded" (i.e., pushed not pulled) from the host system to the mobile client.

IV. Conclusion

The specification provides adequate description under 35 USC 112, first paragraph, for all of the claims of groups I, II, III, and IV.

Respectfully submitted,



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Appl. No. 09/095,325
Reply to Examiner's Answer of July 8, 2003

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